

REMARKS

This is in response to the Office Action mailed on August 19, 2004, and the references cited therewith.

Claims 22-26, 28-34, and 38 are amended, no claims are canceled, and claims 43-46 are added; as a result, claims 22-46 are now pending in this application.

No new matter has been introduced. The amendments to the claims are made to satisfy Applicants' preferences, not necessarily to satisfy any legal requirement(s) of the patent laws, and they are not intended to limit the scope of equivalents to which any claim element may be entitled.

Examiner Interview

On November 12, 2004, Examiner Pham and Applicants' Attorney, Lucinda Price, discussed paragraph 2 on page 2 of the Office Action mailed on August 19, 2004. In particular, the Examiner and Applicants' attorney agreed that "Swanson et al. (US 6,409,312)" was a typographical error and should read "Swanson et al. (US 5,686,949)."

Double Patenting Rejection

Claims 22-39 were rejected under the judicially created doctrine of double patenting over claims 1, 12, 14 and 19 of U.S. Patent No. 6,739,519 in view of Swanson et al. (see above).

Applicants do not concede the obviousness of any of the pending claims over the claims of U.S. Patent No. 6,739,519, nor concede the obviousness of any pending claim over U.S. Patent No. 6,739,519 in view of Swanson. Further, Applicants do not concede the propriety of the rejection under the judicially created doctrine of double patenting over claims of a first patent in view of the disclosure of a second patent.

However, to moot this rejection a terminal disclaimer in compliance with 37 C.F.R. 1.321(b)(iv) will be filed soon by Supplemental Amendment; an unsigned copy is enclosed herewith. The Examiner is requested to note that Applicants are disclaiming the terminal part of the statutory term of any patent granted on the above-identified patent application (Serial No. 10/825,547), which would extend beyond the expiration date of the full statutory term, as

presently shortened by any terminal disclaimers, of U.S. Patent No. 6,739,519. Withdrawal of this rejection is therefore appropriate and is respectfully requested.

Applicants do not disclaim the terminal part of the statutory term of any patent granted on the above-identified patent application (Serial No. 10/825,547), which would extend beyond the expiration date of the full statutory term, as presently shortened by any terminal disclaimers, of Swanson et al. (US 5,686,949).

§102 Rejection of the Claims

Claims 31, 38 and 40 were rejected under 35 USC § 102(b) as being anticipated by Keefe et al. (US 5,635,966). This rejection is respectfully traversed.

Anticipation requires the disclosure in a single prior art reference of each element of the claims under consideration. *In re Dillon*, 919 F.2d 688, 16 USPQ2d 1897, 1908 (Fed. Cir. 1990) (en banc), cert. denied, 500 U.S. 904 (1991).

Applicants were not able to find that Keefe teaches each and every claim element of amended independent claims 31 and 38. In particular, it is respectfully submitted that Keefe does not disclose “wherein fluid flows through the fluid slot in the substrate to the firing chamber to eject from the nozzle” as claimed in independent claim 31. Additionally, it is respectfully submitted that Keefe does not disclose “wherein the cover layer includes a plurality of layers including a primer layer supported by the substrate surface, wherein at least one outer edge of an offset layer of the plurality of layers is offset from a respective outer edge of the primer layer to expose a surface of the primer layer” as recited in claim 38.

Accordingly, independent claims 31 and 38 are in condition for allowance, and Applicants respectfully request that the rejections be withdrawn. In addition, Applicants believe the amended independent claims 31 and 38 are patentable over the art of record, and that the amendments made herein are within the scope of a search properly conducted under the provisions of MPEP 904.02.

Claim 40 depends from claim 38 and incorporates all of the limitations therein. Claim 40 is also asserted to be allowable for the reasons presented above, and Applicants respectfully request notification of same. Applicants consider that additional element(s) of claim 40 further

distinguish over the cited references, and Applicants reserve the right to present arguments to this effect at a later date.

Claims 22-24, 27-30 and 34 were rejected under 35 USC § 102(e) as being anticipated by Mrvos et al. (US 6,409,312). This rejection is respectfully traversed.

Anticipation requires the disclosure in a single prior art reference of each element of the claims under consideration. *In re Dillon*, 919 F.2d 688, 16 USPQ2d 1897, 1908 (Fed. Cir. 1990) (en banc), cert. denied, 500 U.S. 904 (1991).

Applicants were not able to find that Mrvos teaches each and every claim element of amended independent claims 22, 28, and 34. In particular, it is respectfully submitted that Mrvos does not teach “wherein the cover layer includes a primer layer, a chamber layer, a nozzle layer, and a top coat layer” as recited in claim 22, “a top coat layer defining a countersunk bore corresponding to the nozzle” as recited in claim 28, and does not teach “a top coat layer defining a countersunk bore associated with the nozzle” as recited in claim 34.

Accordingly, independent claims 22, 28, and 34 are in condition for allowance, and Applicants respectfully request that the rejections be withdrawn. In addition, Applicants believe the amended independent claims 22, 28, and 34 are patentable over the art of record, and that the amendments made herein are within the scope of a search properly conducted under the provisions of MPEP 904.02.

Claims 23, 24 and 27 depend from independent claim 22, and claims 29 and 30 depend from independent claim 28, and these dependent claims incorporate all of the limitations of the independent claims from which they respectively depend. Claims 23, 24, 27, 29 and 30 are also asserted to be allowable for the reasons presented above, and Applicants respectfully request notification of same. Applicants consider that additional element(s) of claims 23, 24, 27, 29 and 30 further distinguish over the cited references, and Applicants reserve the right to present arguments to this effect at a later date.

§103 Rejection of the Claims

Claims 32-33, 39, 41-42 were rejected under 35 USC § 103(a) as being unpatentable over Keefe et al. in view of Mrvos et al. Claims 25-26 and 35-37 were rejected under 35 USC § 103(a) as being unpatentable over Mrvos et al. in view of Swanson et al. These rejections are respectfully traversed.

Claims 32-33 depend from claim 31 and claims 39, 41, and 42 depend from claim 38, and these dependent claims incorporate all of the limitations of the independent claims from which they respectively depend. Claims 32-33, 39, 41 and 42 are also asserted to be allowable for the reasons presented above, and Applicants respectfully request notification of same. Applicants consider that additional element(s) of claims 32-33, 39, 41 and 42 further distinguish over the cited references, and Applicants reserve the right to present arguments to this effect at a later date.

New Claims 43-46

Claim 43 depends from independent claim 22, claims 44-45 depend from independent claim 28, and claim 46 depends from independent claim 31. These dependent claims incorporate all of the limitations of the independent claims from which they respectively depend. Claims 43-46 are also asserted to be allowable for the reasons presented above, and Applicants respectfully request notification of same. Applicants consider that additional element(s) of claims 43-46 further distinguish over the cited references, and Applicants reserve the right to present arguments to this effect at a later date.

Conclusion

Applicants respectfully submit that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicants' attorney at (352) 373-8804 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 08-2025.

Respectfully submitted,

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By their Representatives,

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Date Nov 19, 2004

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: MS Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 19 day of November, 2004.

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Name

Signature

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